REMARKS

INTRODUCTION

In accordance with the following, reconsideration of the allowability of the claims is respectfully requested.

Claims 1-15 are pending and under consideration.

OBJECTION TO DRAWINGS

FIG. 1 has been objected to for not including a "PRIOR ART" label. Accordingly, the attached replacement sheet for FIG. 1 includes the appropriate "PRIOR ART" label.

REJECTIONS UNDER 35 USC 103

Claims 8, 9 and 15 stand rejected under 35 USC § 103(a) as being obvious over the background of the present application, e.g., FIG. 1, (hereinafter referred to as Prior Art), in view of Shibamoto et al., U.S. Patent No. 6,619,062. This rejection is respectfully traversed.

The Office Action sets forth that Prior Art discloses all the claimed features of independent claims 8 and 15, but fails to disclose the claimed pressure reducing unit. To disclose this pressure reducing unit, the Office Action relies on Shibamoto et al., indicating that Shibamoto et al. discloses a "refrigeration system with a bypass pipe and a pressure reducing unit 17 in the pipe."

The Office Action further indicates that it would have been obvious to modify Prior Art to include a pressure reducing unit in bypass pipe 14b, "for the purpose of ensuring that only gaseous refrigerant flows through the bypass pipe."

Applicants respectfully disagree with the obviousness of modifying Prior Art to include a pressure reducing unit in bypass pipe 14b, as well as the teaching provided by Shibamoto et al. for such a modification.

Independent claims 8 and 15 detail that the claimed bypass pipe connects a bypass hole to the inlet pipe to allow refrigerant bypassed through the bypass hole to enter the cylinder, and the pressure reducing unit reduces pressure of the refrigerant that flows through the bypass pipe.

Prior Art is a variable capacity rotary compressor. Further, Prior Art illustrates a bypass pipe 14 connecting the bypass hole to the inlet pipe to allow refrigerant bypassed through the bypass hole to enter the cylinder.

However, as discussed in the background of the present invention, there is a problem with rotary compressors, in that the refrigerant resident in the bypass pipe may be under "slight" pressure, which causes a mass flow problem when the refrigerant is reintroduced introduced into the compression chamber.

Thus the present application has provided the reason for adding a pressure reducing unit in the bypass pipe, i.e., to counter this "slight" pressure difference.

The Office Action has indicated that the reason for adding the pressure reducing unit 17 of Shibamoto et al. to Prior Art would be to ensuring that only gaseous refrigerant flows through the bypass pipe.

However, there is no evidence in the record that the Office Action recited motivation is appropriate, i.e., the Office Action has failed to provide evidence that either non-gaseous refrigerant flows could exist in the bypass pipe of Prior Art, or whether the same would actually be a problem.

Further, in Shibamoto et al., the pressure reducing capillary tube 17 is used to reduce pressure from the high pressure discharge pipe 14 for introduction to the scroll compressor through operating pressure line 15. Thus, the use of the pressure reducing capillary tube 17 is only for providing operating pressure to operating pressure line 15 *from the high pressure discharge line 14.*

Conversely, Prior Art uses a bypass pipe from a bypass hole in the chamber for providing the bypass pipe with refrigerant, i.e., the refrigerant in Shibamoto et al. for operating pressure line 15 is obtained from the high pressure discharge line while the refrigerant in Prior Art is obtained from a separate bypass hole, not the discharge line.

Thus, as the two compressors are of different types and constructions, with different compression system requirements and techniques, it is respectfully submitted that it would not have been obvious to take a pressure reducing unit from Shibamoto et al., used to step down the pressure from the high pressure discharge line, in the bypass line of Prior Art, which reintroduces refrigerant from a bypass hole to the inlet pipe.

In addition, it is respectfully submitted that the recited motivation for such a modification of Prior Art is not evidenced in the record.

It is well settled that "the Board [and examiners] cannot simply reach conclusions based on [their] own understanding of experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and examiners] must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59

USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings, again noting that the mere fact that the prior art may be modified in a particular manner does **not** make the modification obvious unless the prior art suggested the desirability of that modification.

Thus, as the motivation relied upon in the Office Action is not sufficiently evidenced in the record, it is respectfully submitted that the outstanding rejection fails to meet a prima facie obviousness standard.

Accordingly, as both independent claims 8 and 15 include at least similar allowable features, with differing scope and breadth, and in view of the at least the above, it is respectfully requested that this rejection of claims 8 and 15 be withdrawn and claims 8 and 15 be allowed. For at least similar rationale, it is respectfully submitted that claims depending from independent claims 8 and 15 are also in proper condition for allowance.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,
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AMENDMENTS TO THE DRAWINGS:

The attached drawing includes changes to FIG 1. The replacement sheet containing FIG. 1 replaces the original sheet including FIG. 1.